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Paper No. 8
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zarak Systems Corporation

Serial No. 75/843,132

Lucy B. Arant of Russ, August, Kabat & Kent for Zarak Systems Corporation.

Amy L. Hermansen, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Acting Managing Attorney).

Before Hairston, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 8, 1999, Zarak Systems Corporation filed an intent-to-use application to register on the Principal Register the mark ABACUS for the following goods:
"computer hardware and software for testing communications systems and equipment by generating and switching telephone traffic" in International Class 9.¹ Subsequently, applicant filed an Amendment to Allege Use, with claimed dates of

¹ In its brief on appeal applicant proposed an amendment to its identification of goods whereby the wording after "systems" would be deleted. The Examining Attorney denied the proposed amendment because it broadens the scope of the identification of goods in violation of Trademark Rule 2.71(a).

first use and first use in commerce of 1995, which was accepted by the Examining Attorney.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered mark ABACUS for "computer software for automatic call distribution management" in International Class 9,² as to be likely to cause confusion, mistake or deception.

Applicant has appealed, and briefs have been filed, but applicant did not request an oral hearing.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The marks are identical. This fact "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). "The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J.

² Registration No. 2,242,546, issued May 4, 1999 to NEC Corporation.

McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2000).

We turn to a consideration of the goods in the cited registration and applicant's goods. Applicant's position is that its goods ("computer hardware and software for testing communications systems and equipment by generating and switching telephone traffic") and the registrant's goods ("computer software for automatic call distribution management") are dissimilar because applicant makes "a testing communication system" to test the computer equipment that generates and switches telephone traffic, while registrant's identified computer software is an entry level management information system for users of small departmental call centers.

Applicant also contends that its product costs thousands of dollars and is purchased by producers of computer software (such as registrant), through applicant's direct sales force or exclusive distributors.

The Examining Attorney points out that even though applicant argues that "Applicant's product does not generate and switch telephone traffic" (brief, p. 2), in the information sheet about applicant (submitted by applicant on October 10, 2000) the following statement appears: "Abacus is a modular and expandable test system

that creates telephone traffic (bulk call generator) or switches telephone traffic (central office emulator)."

Further, the Examining Attorney argues that the parties' goods are closely related because applicant's software may be used in connection with registrant's software; that registrant's software for "automatic call distribution management" "most likely includes switching telephone traffic as part of its distribution function" (brief, p. 4); and that the term "management" in registrant's identification of goods is very broad and could encompass a testing function. In support of her position, the Examining Attorney submitted dictionary definitions of the words "switching" and "distribution."

It is, of course, well settled that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services.

See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Also, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, we agree with the Examining Attorney that applicant's goods are closely related to registrant's goods, as identified. Both parties provide computer software relating to telephone traffic. Applicant's computer hardware and software clearly relates to testing communications systems by generating and switching telephone traffic, and the previously registered mark is for automatic call distribution. Applicant acknowledges that registrant might utilize applicant's testing system for registrant's software. Applicant's argument that registrant's computer software is actually an entry level

management information system specifically for users of small departmental call centers is not persuasive because registrant's identification of goods is not so limited.

Moreover, the identifications of goods are not restricted as to the channels of trade and/or the intended purchasers. Because neither party's identification restricts the trade channels or purchasers, the Board must consider that the parties' respective goods could be offered and sold to the same classes of purchasers through all normal channels of trade. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra; *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Even assuming that purchasers of applicant's computer hardware and software are sophisticated and its products are expensive, when the identical mark is used on closely related goods, the relevant purchasers are likely to be confused as to the source of the goods, despite the care taken. Purchasers may believe that registrant is now providing a testing system for its computer software for automatic call distribution management.

According to applicant, there have been no instances of actual confusion in six years of coexistence of applicant's mark and the mark in the cited registration.

However, there is no evidence of applicant's and registrant's geographic areas of sales, or the amount of the sales under the respective marks. Further, there is no information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Finally, applicant argues that ABACUS is a weak mark in the computer field, "as well as in the field of telecommunications services." (Applicant's response to the first Office action, filed October 10, 2000.) Applicant submitted with that response to the Office action, printouts from the Nexis database showing numerous pending applications and registrations, all of which consist of or include the word ABACUS in some manner. A trademark search report from a private database is not evidence of the applications and/or registrations listed therein; and the Board does not take judicial notice of registrations residing in the USPTO. See *In re Duofold Inc.* 184 USPQ 638 (TTAB 1974); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); and *In re F.C.F. Inc.*, 30 USPQ2d 1825 (TTAB 1994). However, the Examining Attorney did not object to or address this material so that applicant could correct its

submission. Therefore, the Board has considered the Nexis report. It is, however, of limited probative value because the existence of pending applications or even of registrations does not prove use of the involved marks and that the relevant public is aware of them. Thus, there is no evidence of record herein on the number and nature of similar marks in use on similar or related goods or services.

In its brief on appeal, applicant referred to a typed list of eleven third-party registrations (brief, pp. 7-8) and stated that copies thereof were attached. No copies were attached, and mere typed lists of registrations are not sufficient to make them of record. These materials were untimely offered into the record pursuant to Trademark Rule 2.142(d) and were not considered.³

Even if applicant had shown that the cited mark is weak, such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

³ We note that even if considered, the third-party registrations referred to in applicant's brief would not alter our decision herein because several of the registrations were for marks which create a different commercial impression, for example, ABACUS-THE EVOLUTION OF TRAVEL, ABEKAS, ABACO BRIDGE.

Based on the identity of the marks, the relatedness of the goods, and the similar or overlapping trade channels and purchasers, we find that there is a likelihood that the relevant purchasing public would be confused when applicant uses the mark ABACUS for "computer hardware and software for testing communications systems and equipment by generating and switching telephone traffic" in view of the previously registered mark ABACUS for "computer software for automatic call distribution management."

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.